

Remarks/Arguments

A. Summary of Claims

No claims have been amended, added, or canceled. Claims 1-64 are pending.

B. Response to Restriction Requirement

The Examiner requests restriction to one of the following two groups: Group I -- Claims 1-61, drawn to a method of coating; and Group II -- Claims 62-64, drawn to a coating system. Restriction Requirement at page 2. In support of this request, the Examiner states that, "Inventions I and II are related as process and apparatus for its practice. The inventions are distinct [because]... the apparatus as claimed can be used to practice another and materially different process, e.g. coating a semiconductor wafer." *Id.*

Applicant elects Group I (*i.e.*, claims 1-61) with traverse.

1. *"Coating A Semiconductor Wafer" is Not a Reasonable Example of a Material Difference Between the Group I and II Inventions*

The system in claim 62 cannot be used to practice the process put forward by the examiner (*i.e.*, coating a semiconductor wafer). Applicant's claimed system is limited to a lens carried by a lens holder and not a semi-conductor wafer carried by a semi-conductor wafer holder. Indeed, the claimed structural features of the system in claim 62 are such that it is limited to a use during an optical lens coating process (*e.g.*, claim 1).

Further, the claimed system could not be used to coat a semi-conductor wafer as proffered by the Examiner. Applicant's claimed holder is suitable to hold an ophthalmic lens (which tend to be millimeter-thick articles) and not a semi-conductor wafer (which tend to be micrometer-thick articles). That is, the size differences between ophthalmic lenses and semi-conductor wafers undermine the Examiner's position that "the apparatus as claimed can be used

to practice another and materially different process, e.g. coating a semiconductor wafer.”
Restriction Requirement.

In addition, ophthalmic lenses may be adequately held by the holder due to their rigidity. Such result would not be obtained with wafers, which are flexible by nature and prone to undergo deformation. Thus, those skilled in the art would not attempt to block semi-conductor wafers by means of the lens holder claimed in claim 62.

Also, semi-conductor wafers are generally coated by vapor phase deposition rather than dip coating as required by the system of claim 62, which comprises a dip coating device.

For at least these reasons, Applicant requests that the Restriction Requirement be withdrawn. *See* MPEP § 806.05(e) (regarding justification for requiring restriction between process and apparatus inventions, “The burden is on the examiner to provide reasonable examples that recite material differences.”).

2. There Is No “Serious Burden” to Search Groups I and II Together

According to the Examiner, Groups I and II require a different field of search, or have acquired a separate status in the art, *etc.* Restriction Requirement at page 2. A different field of search is shown where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention. MPEP § 808.02.

In the present case, the Group II system claims are drafted in such a manner as to practice the Group I coating process claims. For instance, each of the four elements comprised in the claim 62 system, namely the curing device, the lens holder carrying a lens, the corona discharge or atmospheric plasma treatment device and the dip coating device, are used in at least one step of the process of claim 1. Suppressing at least one of the four elements makes it impossible to carry out the claimed process. That is, the searching burden on the Examiner is reduced, as any

search dedicated to the Group I coating process, which uses the Group II system, would necessarily result in identifying documents that are pertinent to both Groups.

The opposite is also true. The Group II system has been especially devised to practice a continuous process for applying a coating onto an optical article, whereby the process is effected without necessitating any manual handling of the lens. Therefore, any search dedicated to the Group II system for implementing the coating process would identify documents pertinent to the Group I coating process.

Applicant requests that the Restriction Requirement be withdrawn for at least these reasons. *See* MPEP § 808.02.

C. Response to the Species Election Requirement

The Examiner requests election between the following two species in the event that Group I is elected:

- A) the embodiment wherein the treatment is a corona discharge treatment with two corona heads oriented towards each other; and
- B) the embodiment wherein the treatment is a corona discharge treatment with a single corona head.

Restriction Requirement at page 3.

Applicants elect species A) (*i.e.*, the embodiment wherein the treatment is a corona discharge treatment with two corona heads oriented towards each other) and believe that claims 1-60 and 62-64 read on the elected species. This election is made with traverse.

Species A) and B) are not distinct. As discussed in the specification, the two headed corona system allows treatment of the two main faces of an optical lens, almost simultaneously. Specification, page 6, lines 23-26. As a consequence, the single headed system and the two headed system are obvious variants, which are not patentably distinct.

Further, the two identified embodiments do not belong to separate classes or subclasses and different fields of search are not required. As explained in the specification, embodiments (a) and (b) exhibit common properties, a common utility, and share substantial structural features which are essential to that utility. A common utility includes activating a surface with the aim of improving adhesion, or eliminating an outer coating. Specification, page 2, lines 15-25. A common structure feature also exists; each embodiment shares a structural feature of at least one corona head. The heads are essential to the utility.

Any search regarding the two headed corona system of embodiment (a) would necessarily identify single head corona systems according to embodiment (b), and *vice versa*. As such, embodiments (a) and (b) do not belong to separate classes or subclasses, nor are different fields of search required of these embodiments.

Applicant requests withdrawal of the Species Election Requirement.

D. Conclusion

Applicant requests that the Restriction and Species Election Requirements be withdrawn for at least the reasons discussed above. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3020.

Respectfully submitted,



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